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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/955,095 | 09/19/2001 | Hiroshi Koyama | P281124 U3-9613-B | 9734 |

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EXAMINER

DAVIS, ROBERT B

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 05/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,095

Applicant(s)

KOYAMA ET AL.

Examiner

Robert B. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/649,306.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 9-12 and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Sharp (UK specification 1,382,583: figures 1-10; page 1, lines 25-49 and 68-90; page 2, lines 21-26, 48-62 and 69-71; page 3, lines 44-61 and 117-128, and page 4, line 106 to page 5, line 8).

Sharp teaches an apparatus for encapsulating an insert comprising: a die set (16, 20) which defines a molding cavity, hold members (27) for releasably holding an insert (37) within the mold cavity for properly positioning the insert in relation to the mold cavity surfaces, means for injecting molten resin into the cavity (page 3, lines 101-103), means for separating the hold member from the insert (sliders 29 which move the holders from the insert holding position to the retracted position wherein the holders are flush with the mold cavity, see page 2, line 124 to page 3, line 22), means for heating a surface of the hold member to a temperature higher than a temperature of an inner surface of the die set which is electrical heater (74). The reference also teaches forming the holding members (27) with a ceramic tip (41) that insulates the pin from the molding resin (see page 3, lines 44-61). The reference further teaches water passages (16a and 20a) for the passage of cooling water to cool the molten plastic injected into

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the mold cavity. The reference further teaches means for stopping the supply of electricity to the heaters in the holding members upon retraction of the holding members that constitutes a controller for controlling the cooling of the mold.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharp taken together with Westover (5,004,893: column 2, lines 50-68 and column 7, lines 40-59).

Sharp discloses all claimed features except for the heater being made of a conductive ceramic.

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Westover discloses an electric heater having an outer insulating ceramic and an inner conductive ceramic which provides an improvement over conventional heaters because the heater does not require sophisticated clips or terminals to withstand high temperatures and the heater is rugged and reliable.

It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the apparatus of Sharp by using a ceramic heater having a conductive ceramic as disclosed by Westover because the use of a two component ceramic heater provides a rugged and reliable heating device which does not require sophisticated clips or terminals.

Response to Arguments

6. Applicant's arguments with respect to claims 9-18 have been considered but are moot in view of the new ground(s) of rejection. The Sharp reference was cited in the specification of GB 1425837 A that was cited in the IDS of 12/30/02.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Davis whose telephone number is 703-308-2625. The examiner can normally be reached on Monday-Friday 9-5:30.

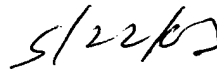
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read 'R. B. Davis', with a long horizontal flourish extending to the right.

Robert B. Davis
Primary Examiner
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Handwritten initials or date '5/22/03' in black ink.

May 22, 2003